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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/089,580

07/31/2002

Michael Langer

740-65

2526

616 7590 07/10/2007
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EXAMINER

ALI, MOHAMED HATEM

ART UNIT

PAPER NUMBER

3609

MAIL DATE

DELIVERY MODE

07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,580

Applicant(s)

LANGER ET AL.

Examiner

Mohamed H. Ali

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/31/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11-25-2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
proper headings and arrangement of specification are missing.
Appropriate correction is required.

Claim Objections

2. **Claim 10** is objected to because of the following informalities:
abbreviated terms should be spelled out the first time they are introduced e.g. the term "MSISDN"
Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. **Claim 24** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. The claims begin by discussing a method, and the body of the claims discusses the specifics of a system.

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"A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only." See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

Further, the process claimed contains software (data) structures not claimed as embodied in computer-readable media and therefore are descriptive material *per se* and are not statutory because they are not capable of causing function change in a computer. See *In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 24** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. It is therefore unclear whether Applicant is claiming a process or a machine. See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

Additionally, Claim 24 is indefinite since it recites a method without any process steps. Applicants are reminded "it is generally the rule that patentability of a method claim must rest on the method steps recited, not on the structure used, unless that structure affects the method steps." *Leesona Corp. v. US*, 530 F.2d 896, 908 (US Ct Clms 1976). It is the Examiner's position that the recited structural limitations do not affect the

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method steps since the structural limitations describe aspects of the intended use of the process steps.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 10 - 24** are rejected under 35 U.S.C. 102(e) as being anticipated by Stadelmann (US 6,415,156 B1).

As per claim 10, Stadelmann discloses a method of payment for goods or services on the Internet (col.1, line 18; via Internet, on line services) by means of a mobile wireless Internet terminal (col.1, lines 2-7; via a mobile radio telephone with GSM system), the method comprising;

initiating a payment transaction (col. 1, lines 54-65);

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providing a customer with access to a payment gateway (col. 2, lines 13-20; via the application 41 as the "validation Platform") via said mobile wireless Internet terminal, wherein said payment gateway is located by an IP address (col. 3, lines 24-30; via inter alia IMSI in SIM card 10);

allowing a provider access to said payment gateway via a server (col.), lines 64-67 through col.4, lines 1-2), wherein information about the customer is stored in said payment gateway;

establishing a minipayment account in said payment transaction (col. 2, lines 50-51);

transmitting from said server, as a provider message, transaction data including provider identification information, payment option supported by the provider, and the IP address of the payment gateway, to the customer's mobile wireless Internet terminal and also to said payment gateway (col. 1, lines 55-65; via goods ordering process);

adding the customer's temporary IP address (SIM card 10) as customer identification;

allowing the customer to review said transaction data, as a customer message to the payment gateway, said transaction data having been received by the customer from the provider (col. 3, lines 12-20);

synchronizing said provider and customer messages (col. 3, lines 12-20);

comparing said provider and customer messages to determine whether they match (col. 3, lines 20-25; via if he agrees with the price and the conditions);

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determining and checking the customer's MSISDN (col. 2, lines 5-25; via SIM card 10, GSM or UMTS and SMSC 41) and customer information on the basis of the customer's IP address (SIM card 10); and

performing a deduction from the minipayement account online if said provider and customer messages match (col. 4, lines 1-5).

As per claim 11, Stadelmann discloses no electronic financial information and no customer information is stored in said terminal after the transaction (col. 3, lines 40-45; via but no data concerning purchased service, product or information)

As per claims 12 and 13, Stadelmann discloses the step of securing each payment transaction with a personal identification number (PIN) (col. 4, line 1; via PIN).

As per claims 14 and 15, Stadelmann further discloses sensitive data remains securely in the mobile wireless network and is not transmitted over the Internet (col. 3, lines 23-29; via subscriber Identity stored in secured memory area of SIM card 10).

As per claims 16 and 17, Stadelmann also discloses no additional encryption methods are necessary (col. 2 and 3, lines 66- 67 and 1-2; via may be preferred by TTP but not required).

As per claims 18 and 19, Stadelmann further discloses no additional authentication method is necessary because the authentication of the customer is performed by the mobile wireless network (col. 2, lines 17-20; via agreement and SIM card 10).

As per claims 20 and 21, Stadelmann discloses the provider's server recognizes which GSM operator the customer belongs to on the basis of the IP address range (col. 2, lines 4-55; via services center 41, computer, database 421 and address in SIM card 10).

As per claims 22 and 23, Stadelmann also discloses that the payment gateway generates an electronic invoice for the dealer's account for each transaction performed (col. 4, lines 5- 20; via automatic report by e-mail or fax).

As per claim 24, Stadelmann discloses a method of accounting on the Internet via a mobile wireless communication system (col.1, lines 1-7), a combination of provider software with (Internet) payment systems (col. 2, line 41; via computer program in the service center 41) and Wireless application Protocol (WAP) terminals (col. 2, line 65). - -

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ray et al (6,067,529) discloses a system and method for sending a short message containing purchase information to a destination terminal.

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Levechin et al (UA 7,089,208 B1) discloses system and method electronically exchanging value among distributed users.

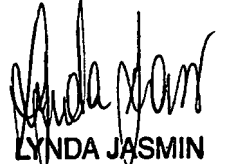
Pekka (EP 0 917 327 A1) method and system for performing electronic money transactions.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed H. Ali whose telephone number is 571-270-3021. The examiner can normally be reached on 7-30 to 5.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mohamed H Ali
Examiner
Art Unit 3609


LYNDA JASMIN
6/21/2007
SUPERVISORY PATENT EXAMINER